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Maria Adamczyk

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EXAMINER

PATEL, HEMANT SHANTILAL

ART UNIT

PAPER NUMBER

2614

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/647,760	ADAMCZYK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hemant Patel	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 21-24, 26-31, 33-38 and 40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-24, 26-31, 33-38 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 19, 2007 has been entered. Claims 21-24, 26-31, 33-38, 40 are pending in this application.

### ***Response to Amendment***

2. Applicant's arguments with respect to claims 21-24, 26-31, 33-38, 40 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 21-24, 26-31, 33-38, 40 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 21 recites added limitation "providing an option to reconnect the subscriber with the voicemail server;"

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and "in response to receiving a user input to reconnect the subscriber with the voicemail server", Independent claims 28 and 35 recites "provide an option to reconnect the subscriber with the voicemail server and, in response to receiving user input to reconnect the subscriber with the voicemail server". The only disclosure by the instant application is to receive disconnect signal such as a disconnect event, the input of particular digits, or the like, and in response to this IP releases the subscriber's communication, which is routed to the VMS after querying SCP (Specification, pg. 18, ll. 3-pg. 19, ll. 3).

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 21-24, 26-27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,650,740 B1 (hereinafter referred to as Parent '740) in view of Ridgley (US Patent No. 6,195,418 B1), and further in view of Scherer (US Patent No. 6,137,870).

***Regarding claims 21-24, 26-27,*** the claims 1-5 of Parent '740 recite limitations similar to that recited in claims 21-24, 26-27 of the instant application except the patented claims do not recite added limitations of "wherein connecting a communication between the subscriber and the caller includes routing the communication through a directory number associated with the subscriber, such that the communication appears to originate from a the directory number associated with the subscriber to facilitate creation of a billing record entry associated with the directory number, the directory number being different than the accessing number" and "in response to an indication to disconnect the communication between the subscriber and the caller, reconnecting the subscriber with the voicemail server".

However, in the same field of endeavor, Ridgley teaches of a voice mail system allowing a user (called party), listening to the voice message left by the caller, to make a return call (callback) to the calling party that left the message by transferring the user's original voice mail call to the calling party and billing the user for the return call portion after the transfer (col. 7, ll. 34-col. 8, ll. 25).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the claims 1-5 of Parent '740 to bill the called party for the return call portion after the transfer as taught by Ridgley in order to charge the called

subscriber for the use of the special facility of automatic return call since the called subscriber optionally selected the convenience of automatically calling back.

The claims 1-5 of Parent '740 modified by Ridgley do not teach about mechanism involved in billing.

However, in the same field of endeavor, Scherer teaches of connecting a communication between the subscriber and a destination number, wherein the gateway platform enables routing of the communication through a directory number (subscriber home phone number), such that the communication appears to originate from the directory number associated with the subscriber to facilitate creation of a billing record entry associated with the directory number (replacing calling line ANI with the home phone number), the directory number (home phone number) being different than the accessing number (calling line ANI) (col. 24, ll. 30-51).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to further modify the claims 1-5 of Parent '740 modified by Ridgley to enable the subscriber to substitute information as taught by Scherer so that "The call may be billed through the LEC phone bill or through any other form of billing (e.g., credit card, private arrangement, etc.)" (Scherer, col. 24, ll. 38-40).

7. Claims 28-31, 33-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-11 of U.S. Patent No. No. 6,650,740 B1 (hereinafter referred to as Parent '740) in view of Ridgley (US Patent No. 6,195,418 B1), and further in view of Scherer (US Patent No. 6,137,870).

**Regarding claims 28-31, 33-34**, the claims 6-11 of Parent '740 recite limitations similar to that recited in claims 28-31, 33-34 of the instant application except the patented claims do not recite added limitations of "wherein facilitating a communication between the subscriber and the caller includes routing the communication through a directory number associated with the subscriber, such that the communication appears to originate from a the directory number associated with the subscriber to facilitate creation of a billing record entry associated with the directory number, the directory number being different than the accessing number" and "a reconnecting component configured to, in response to an indication to disconnect the communication between the subscriber and the caller, reconnect the subscriber with the voicemail server".

These are claims for a system substantially implementing a method as claimed in claims 21-24, 26-27. Shaffer teaches of such a system (Fig. 1). These claims 28-31, 33-34 are rejected for the same reasons as stated in the Double Patenting rejection for claims 21-24, 26-27 above.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 21-23, 27-30, 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer (US Patent No. 6,567,507 B1), and further in view of Ridgley (US Patent No. 6,195,418 B1), and further in view of Scherer (US Patent No. 6,137,870).

***Regarding claim 21***, Shaffer teaches of a method to make a reply call to a voice mail message, comprising:

receiving a communication request from a voicemail server (col. 4, ll. 1-3), the communication request resulting from a subscriber accessing a voicemail message created by a caller via the voicemail server and further resulting from the subscriber sending a command to connect the subscriber with the caller (col. 3, ll. 38-40);

connecting a communication between the subscriber and the caller without utilization of the voicemail server (col. 4, ll. 3-7); and

in response to an indication to disconnect the communication between the subscriber and the caller, providing an option to reconnect the subscriber with the voicemail server (this limitation is interpreted as the system providing an option i.e.



feature to reconnect the subscriber with the voicemail server instead of disconnecting the subscriber) (col. 4, ll. 7-10, 12-14);

in response to receiving a user input to reconnect the subscriber with the voicemail server (the fact that user presses FLASH key instead of hanging up, the FLASH key is also user input to reconnect with voicemail server), reconnecting the subscriber with the voicemail server (col. 4, ll. 7-10, 12-14).

Shaffer does not teach about billing.

However, in the same field of endeavor, Ridgley teaches of a voice mail system allowing a user (called party), listening to the voice message left by the caller, to make a return call (callback) to the calling party that left the message by transferring the user's original voice mail call to the calling party and billing the user for the return call portion after the transfer (col. 7, ll. 34-col. 8, ll. 25).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Shaffer to bill the called party for the return call portion after the transfer as taught by Ridgley in order to charge the called subscriber for the use of the special facility of automatic return call since the called subscriber optionally selected the convenience of automatically calling back.

Shaffer modified by Ridgley does not teach about mechanism involved in billing.

However, in the same field of endeavor, Scherer teaches of connecting a communication between the subscriber and a destination number, wherein the gateway platform enables routing of the communication through a directory number (subscriber home phone number), such that the communication appears to originate from the

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directory number associated with the subscriber to facilitate creation of a billing record entry associated with the directory number (replacing calling line ANI with the home phone number), the directory number (home phone number) being different than the accessing number (calling line ANI) (col. 24, ll. 30-51).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to further modify Shaffer modified by Ridgley to enable the subscriber to substitute information as taught by Scherer so that "The call may be billed through the LEC phone bill or through any other form of billing (e.g., credit card, private arrangement, etc.)" (Scherer, col. 24, ll. 38-40).

**Regarding claim 22**, Shaffer teaches of a re-call protocol element from the voicemail system to the switch (col. 4, 1-7).

**Regarding claim 23**, Shaffer teaches of a re-call protocol element that is a remote parameter sent from the voicemail system to the switch to initiate remote operation in the switch and this element contains phone number as routing information (col. 3, ll. 52-56) and also contains call identification information (col. 3, ll. 45-46).

**Regarding claim 27**, Shaffer teaches of terminating of the communication at the Intelligent Network element (INE) (Fig. 1, item 22; switch is a network element and is intelligent to detect a call, collect digits, make routing decisions, determine destination and terminate the call to the destination). Ridgley teaches of an Intelligent Network element (INE) (Fig. 2, item 13).

**Regarding claim 28**, it recites a system substantially implementing a method as claimed in claim 21. Shaffer teaches of such a system (Fig. 1). Refer to rejection for claim 21.

**Regarding claim 29**, refer to rejection for claim 22 and claim 28.

**Regarding claim 30**, refer to rejection for claim 23 and claim 29.

**Regarding claim 34**, refer to rejection for claim 27 and claim 28.

**Regarding claim 35**, it recites computer readable medium with logics configured substantially implementing a method as claimed in claim 21. Shaffer teaches of a system with components that use computers and computer readable mediums as is well known in the art (Fig. 1). Refer to rejection for claim 21.

**Regarding claim 36**, refer to rejection for claim 22 and claim 35.

**Regarding claim 37**, refer to rejection for claim 23 and claim 36.

11. Claims 24, 31, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer modified by Ridgley and Scherer as applied to claims 22, 29, 36 above, and further in view of Ekstrom (US Patent No. 6,148,069).

**Regarding claim 24**, Shaffer teaches of using industry standard signaling such as S7 (i.e. SS7, col. 4, ll. 39-40). Scherer teaches of using ISDN and SS7 protocols (col. 6, ll. 55-59; col. 8, ll. 39-42).

Shaffer modified by Ridgley and Scherer does not specifically teach of GR-1129 that is another industry specified signaling standard.

However, in the same field of communication, Ekstrom teaches of using GR-1129 for communication among SCP, SSP and IP (col. 1, ll. 35-38).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Shaffer modified by Ridgley and Scherer to use GR-1129 signaling standard as taught by Ekstrom in order to permit "the SSP to keep track of billing records and release the SSP-IP voice/data connection when it is no longer required while maintaining control of the original call" (Ekstrom, col. 1, ll. 41-44).

***Regarding claim 31***, refer to rejection for claim 24 and claim 29.

***Regarding claim 38***, refer to rejection for claim 24 and claim 36.

12. Claims 26, 33, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer modified by Ridgley and Scherer as applied to claims 21, 28, 35 above, and further in view of Berberich (US Patent No. 5,818,919).

***Regarding claim 26***, Shaffer teaches of using industry standard signaling such as S7 (i.e. SS7, col. 4, ll. 39-40). Scherer teaches of using ISDN and SS7 protocols (col. 6, ll. 55-59; col. 8, ll. 39-42).

Shaffer modified by Ridgley and Scherer does not specifically teach of ISUP that is another industry specified signaling standard.

However, in the same field of communication, Berberich teaches of using ISUP messages between the switch and the platform (i.e. Intelligent peripheral) (co. ll. 5, ll. 7-9), with ISUP parameters to provide called party number as a subscriber-specific number to terminate the call (col. 8, ll. 60-64).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Shaffer modified by Ridgley and Scherer to use ISUP messages with the required parameters as taught by Berberich so that "the calling party's identity is carried forward in the ISUP parameter set" (Berberich, col. 9, ll. 1-2) between different switches (Berberich, Fig. 1, items 100, 160, ..., 170) in the network.

***Regarding claim 33***, refer to rejection for claim 26 and claim 28.

***Regarding claim 40***, refer to rejection for claim 26 and claim 35.

13. Claims 27, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer modified by Ridgley and Scherer as applied to claims 21, 28 above, and further in view of Albers (US Patent No. 6,229,887 B1).

***Regarding claim 27***, Shaffer teaches of terminating of the communication at the switch (Fig. 1, item 22; switch is a network element and is intelligent to detect a call, collect digits, make routing decisions, determine destination and terminate the call to the destination). Ridgley teaches of an Intelligent Network element (INE) (Fig. 2, item 13).

Also, in the same field of communication, Albers teaches of using Intelligent Peripheral (IP, Intelligent Network Element), where the call is terminated (col. 17, ll. 9-40).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Shaffer modified by Ridgley and Scherer to terminate the call at the IP as taught by Albers so that "it requires only one dedicated link between the IP and the surveillance premises" (Albers, col. 17, ll. 28-30) "in contrast to such a

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dedicated link being required between the surveillance premises and a large number of central offices, if the totality of the bridging occurred in a central office" (Albers, col. 17, ll. 30-33).

***Regarding claim 34,*** refer to rejection for claim 27 and claim 28.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant Patel whose telephone number is 571-272-8620. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hemant Patel  
Examiner  
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